REMARKS

These above amendments and these remarks are in reply to the Office Action mailed March 18, 2003. No fee is due for the addition of any new claims.

Claims 32-56 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected Claims 32-56 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,317,797 ("*Clark*") in view of U.S. Patent No. 5,684,990 ("*Boothby*"). The present Response amends Claims 32 and 45, leaving for the Examiner's present consideration Claims 32-56. Reconsideration of the rejections is requested.

I.   RESPONSE TO REJECTION OF CLAIMS 32-56 UNDER 35 U.S.C. §103(a)

Claims 32-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Clark et al.* (U.S. Patent No. 6,317,797), in view of *Boothby* (U.S. Patent No. 5,684,990).

It is respectfully submitted that *Clark* and *Boothby*, either alone or in combination, fail to teach or suggest each of the limitations of Claims 32-56 and cannot render these claims obvious.

A.   Claims 32-35

In paragraph 5 of the present Office Action, the Examiner states that "[a]pplicant's arguments with respect to claims 36-56 have been considered but are moot in view of the new ground(s) of rejection." *Office Action*, page 10, para. 5. However, the Examiner makes no indication that Applicants' arguments made in Response D filed January 17, 2003, as to the allowability of Claims 32-35 over *Clark* in view of *Boothby* have been considered. Applicant, however, has presented the substance of that discussion with additional argument below.

Amended Claim 32 includes, among other limitations, "recording a file identification responsive to a modification to a file of said selected file type." It is respectfully submitted that *Clark* fails to teach or suggest

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this limitation. *Clark* (col. 16, lines 3-7) recites, "[i]f the dates or times are different, control proceeds to step 640, where the first different file is indicated. Control proceeds to step 642 where the two files are scanned to determine if there are any differences. Control proceeds to step 644 to determine if any differences were found."

"Control proceeds to step 640, where the first different file is indicated" refers to reference numeral 640 of Fig. 12, which states "point to first file." *Id.* This cited language of *Clark* merely references pointing to the first file having different times associated with the respective versions of the file in order to begin the next operations of the method disclosed in Fig. 12. The cited portion does not mention recording at all, much less "recording a file identification," as recited in Claim 32. *Clark* merely discloses passing control between two steps described with respect to Fig. 12. This language does not teach or suggest "recording a file identification responsive to a modification to a file of said selected file type," as recited in Claim 32.

Moreover, the method taught by *Clark* does not illustrate a need for "recording a file identification responsive to a modification to a file of said selected file type," as recited in Claim 32. The method of *Clark* begins by developing "the various host and handheld file names, types and directories." *Id.*, col. 15, lines 62-64. After developing, it is determined "if the dates or times are different for the particular files. If not, control proceeds to step 636 where a synchronization flag is set." *Id.*, col. 15, lines 65-67. Thus, *Clark* teaches determining if the dates and times are different for all the developed files. Claim 32, however, recites "recording a file identification responsive to a modification to a file of said selected file type," such that only files that have been modified need to be compared to determine which is more recent.

Boothby also fails to teach or suggest "recording a file identification responsive to a modification to a file of said selected file type," as recited in Claim 32, and thus, fails to cure the deficiency identified in *Clark*. In *Boothby*, "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file (step 205)." *Boothby*, col. 5, lines 63-65. After retrieval

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of the records, "all mapped fields of the handheld record and status file record are compared." *Id.*, col. 6, lines 53-55. After the comparison, a status indicator is set, based on a matching of the fields. *Id.* Thus, *Boothby* teaches setting a status indicator <u>after a comparison</u> of records rather than "recording a file identification responsive to a modification to a file of said selected file type," as recited in Claim 32. The status indicator of *Boothby* is set after a comparison, whereas no comparison is required in Claim 32 before "recording a file identification."

It is respectfully submitted that *Clark* and *Boothby*, either alone or in combination, fail to teach or suggest, "recording a file identification responsive to a modification to a file of said selected file type," as recited in Claim 32.

Amended Claim 32 also includes the limitation "determining, subsequent to said step of identifying and without user intervention, whether said modified file on said first computer is more recent than said identified file on said second computer." *Clark* (604 of Fig. 11; col. 16, lines 8-12) is cited for the disclosure of this limitation. It is respectfully submitted that *Clark* does not teach or suggest this limitation.

The corresponding text to 604 of Fig. 11 teaches that, "control proceeds to step 604 to determine if the files have different dates or times." *Clark*, col. 15, lines 48-50. Claim 32, however, recites "determining, ...whether said modified file on said first computer is <u>more recent</u> than said identified file on said second computer." (*Emphasis added*). *Clark* merely determines whether the files have <u>different</u> dates or times, not whether one is <u>more recent</u> than the other. *Clark* continues by explaining that if the dates and times are different, "control proceeds to step 606 where the handheld file is transmitted to the host computer, assuming that entry will be done only at the handheld computer H as this where the expenses are being incurred." *Id.* at lines 48-54. *Clark* assumes that entries are being done only at the handheld such that if the files have <u>different</u> dates and times, the handheld file is transmitted to the host computer. Thus, this portion of *Clark* does not teach "determining, subsequent to said step of identifying and without user intervention, whether said

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modified file on said first computer is more recent than said identified file on said second computer," as recited in Claim 32.

The Examiner also cites *Clark*, col. 16, lines 8-12 for teaching this limitation. The cited portion discloses, "[i]f so, control proceeds to step 648 to determine if the entire file is new. If so, control proceeds to step 650, where the file is added to the appropriate end, either the host computer or the handheld computer H." *Clark* is merely teaching to determine if an "entire file is new," not, "whether said modified file on said first computer is <u>more recent</u> than said identified file on said second computer," as recited in Claim 32 (*emphasis added*).

To understand the portion cited by the Examiner, the prior steps in the method being discussed by *Clark* must be considered. The method of *Clark*, teaches "to determine if the dates and times are <u>different</u> for the particular files." *Id.*, col. 15, lines 65-66 (*emphasis added*). If so, "control proceeds to step 642 where the two files are scanned to determine if there are any differences." *Id.*, col. 16, lines 6-7. If there are differences, *Clark* teaches to "determine if the entire file is new." *Id.* at lines 8-11. If it is, "the file is added to the appropriate end." *Id.* If the file was not new but only edited, *Clark* teaches that a "viewer module 226 is activated and the particular differences are highlighted and shown to the user so that he can make a proper decision." *Id.* at lines 12-16. Accordingly, at this point, *Clark* teaches user intervention whereby "the user selects whether to keep the handheld or host or both files or merge the files." *Id.* at lines 18-19.

Thus, *Clark* teaches determining if the dates or times are <u>different</u>, scanning the documents, adding files that are entirely new, and presenting edited files to the user to make a decision. *See id.* Accordingly, *Clark* does not teach or suggest "determining, subsequent to said step of identifying and without user intervention, whether said modified file on said first computer is more recent than said identified file on said second computer," as recited in Claim 32.

Claim 32 additionally includes the limitation, "transferring said modified file to said second computer and replacing said identified file on said second computer with said modified file on said first computer, only if it is determined that said modified file on said first computer is more recent than said identified file on said second computer." *Clark* (606 of Fig. 11; col. 16, lines 8-12) is cited for the disclosure of this limitation. It is respectfully submitted that *Clark* does not teach or suggest this limitation.

The text corresponding to *Clark,* 606 of Fig. 11, states that if the file names have <u>different</u> dates or times, "control proceeds to step 606 where the handheld file is transmitted to the host computer." *Clark*, col. 15, lines 50-52. Thus, *Clark* transmits the handheld file to the host if the dates or times are merely <u>different</u>. Claim 32, however, recites, "transferring said modified file to said second computer and replacing said identified file on said second computer with said modified file on said first computer, <u>only if it is determined</u> that said modified file on said first computer is <u>more recent</u> than said identified file on said second computer," (*emphasis added*). Thus, this portion of *Clark* does not teach or suggest this limitation of Claim 32.

Clark, col. 16, lines 8-12, is also cited for teaching this limitation. As previously discussed, *Clark* teaches determining if the dates or times are <u>different</u>, scanning the documents, adding files that are entirely new, and presenting edited files to the user to make a decision. As further discussed, *Clark* teaches that "the user selects whether to keep the handheld or host or both files or merge the files." *Clark*, col. 16, lines 18-19. While not explicitly discussed in *Clark*, presumably the files would have to be transferred to the same machine so that the differences could be presented to the user to make a selection as to which to keep. Thus, this portion of *Clark* does not teach or suggest "transferring said modified file to said second computer and replacing said identified file on said second computer with said modified file on said first computer, <u>only if it is determined</u> that said modified file on said first computer is <u>more recent</u> than said identified file on said second computer," as recited in Claim 32 (*emphasis added*).

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Boothby also does not teach or suggest "transferring said modified file to said second computer and replacing said identified file on said second computer with said modified file on said first computer without user intervention, only if it is determined that said first date and time is more recent than said second date and time," as recited in Claim 32. As taught by *Boothby*, "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65. Thus, *Boothby* teaches retrieving records and comparing them. Accordingly, *Boothby* does not teach "transferring .... and replacing ...., only if its determined that said first date and time is more recent than said second date and time," as recited in Claim 32. *Boothby* retrieves to make its comparison.

Clark and *Boothby*, either alone or in combination, do not teach or suggest each of the limitations of Claim 32. Accordingly, Claim 32 is believed patentable over *Clark* in view of *Boothby*.

Claims 33-35 ultimately depend from Claim 32 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claims 33-35 add their own limitations which render them patentable in their own right. Applicants reserve the right to argue those limitations should it become necessary in the future.

Accordingly, Claims 32-35 are believed patentable under 35 U.S.C. §103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejection of Claims 32-35 is requested.

B. **Claims 36-38**

Claim 36 includes, among other limitations, "retrieving said item of information from said first computer, only if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer." The Examiner cites *Clark*, col. 3, lines 14-17, lines 31-34; col. 14, lines 41-60 for the disclosure of this limitation. It is respectfully submitted that *Clark* does not teach of suggest this limitation.

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Col. 3, lines 14-17 teach that when the handheld and host are actively connected, the handheld "automatically captures updated data in the host computer which is also contained in the handheld computer. In this manner, while the two are physically connected automatic synchronization of the data is performed in real time." This portion teaches automatic capture of data while two devices are connected. There is no teaching or suggestion of "retrieving said item of information from said first computer, <u>only</u> if it is determined that said item of information stored on said first computer is <u>more recent</u> than said corresponding item of information stored on said second computer," as recited in Claim 36 (*emphasis added*).

Col. 3, lines 31-34 teach that "[i]nformation newly entered into the handheld computer is preferably automatically updated to the host computer as it is assumed that the user is the master of the information." This merely teaches updating the host computer with information entered into the handheld. Information is automatically updated to the host computer "as it is <u>assumed</u> that the user is the master of the information." *Id.* (*emphasis added*). Thus, information is updated in one direction based on an assumption. This does not teach or suggest, "retrieving said item of information from said first computer, only if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer," as recited in Claim 36.

Col. 14, lines 41-60, teaches that, "the appropriate host file and handheld file names are obtained to allow comparison. Control proceeds to step 554 to determine if the last dates or times of the two files are different." Thus, *Clark* teaches obtaining the host file and handheld file names and determining if the dates and times of the two files are different. As the Examiner states, "comparison to determine that the files <u>obtained</u> from the host computer is not previously stored on the handheld computer." *Office Action*, page 5 (*emphasis added*). Obtaining and determining cannot teach or suggest "retrieving said item of information from said first computer, <u>only</u> if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer,"as recited in Claim

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36 (*emphasis added*). Claim 36 retrieves the information after making a determination, not obtaining information in order to make a determination as described by *Clark*.

Boothby also teaches to retrieve then make comparisons and thus, does not teach or suggest "retrieving said item of information from said first computer, <u>only</u> if it is determined that said item of information stored on said first computer is more recent than said corresponding item of information stored on said second computer," as recited in Claim 36. As taught by *Boothby*, "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65.

Clark and *Boothby*, either alone or in combination, do not teach or suggest each of the limitations of Claim 36. Accordingly, Claim 36 is believed patentable over *Clark* in view of *Boothby*.

Claims 37 and 38 ultimately depend from Claim 36 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claims 37-38 add their own limitations which render them patentable in their own right. Applicants reserve the right to argue these limitations should it become necessary in the future.

Accordingly, Claims 36-38 are believed patentable under 35 U.S.C. §103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejection of Claims 36-38 is requested.

C.   Claims 39-40

The Examiner stated that "[a]s to claim 39, all limitations have been addressed in the analysis of claim 36 above, and this claim is rejected on that basis."

However, Claim 39 includes, among other limitations, "providing said item of information to said first computer, only if it is determined that said item of information stored on said second computer is more recent than said corresponding item of information stored on said first computer." As stated above, *Clark* teaches obtaining host file and handheld file names, then determining if the dates and times of the two files are

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different. Accordingly, *Clark* does not teach or suggest "providing said item of information to said first computer, only if it is determined that said item of information stored on said second computer is more recent than said corresponding item of information stored on said first computer," as recited in Claim 39.

As discussed, *Boothby* teaches that "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65. Thus, *Boothby* does not teach or suggest the above limitation of Claim 39.

Clark and *Boothby*, either alone or in combination, do not teach or suggest each of the limitations of Claim 39. Accordingly, Claim 39 is believed patentable over *Clark* in view of *Boothby*.

Claim 40 ultimately depends from Claim 39 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claim 40 adds its own limitations which renders it patentable in its own right. Applicants reserve the right to argue these limitations should it become necessary in the future.

Accordingly, Claims 39 and 40 are believed patentable under 35 U.S.C. § 103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejection of Claims 39 and 40 is requested.

D.   **Claims 41-44**

Amended Claim 41 includes, among other limitations, "a first monitoring means, for monitoring said computing device for an occurrence of at least one activity." It is respectfully submitted that *Clark* and *Boothby*, either alone or in combination, fail to teach or suggest this limitation.

The Examiner cites *Clark* (monitor of computer C, Fig. 1C) for the disclosure of a first monitoring means. As described in Applicants' specification, the "Work Monitor keeps track of the work the user does on his home PC including files the user creates, modifies, or accesses; calls the user makes and receives; and faxes the user sends and receives. The user specifies the kinds of files the activities the user wants pcTELECOMMUTE to monitor and how long the user wants the activities to remain in the WORK MONITOR LOG." *Specification*, page 6, lines 13-17. The monitor disclosed in *Clark* is merely a display

device. Display devices are not "work monitoring means" as claimed and described by Applicant in Claim 41. Accordingly, *Clark* does not teach or suggest a "work monitoring means," as recited in Claim 41.

The Examiner also cites *Clark* ("obtain host file names," 552 of Fig. 10) for teaching "for monitoring said computing device for an occurrence of at least one activity," as recited in Claim 41. *Clark*, however, teaches that, "[t]he sequences commence at step 552, where the appropriate host file and handheld file names are obtained to allow comparison." *Id.*, col. 14, lines 56-59. *Clark* then teaches that, "[c]ontrol proceeds to step 554 to determine if the last dates or times of the two files are different." *Id.*, col. 14 lines 59-60. Thus, *Clark* teaches that files and file names must be obtained and compared while Claim 41 recites "monitoring said computing device for an occurrence of at least one activity." *Clark* is not monitoring. *Clark* is obtaining "to allow comparison." *Id.* Clark merely determines if two files are different from a comparison. *Clark* does teach "monitoring said computing device for an occurrence of at least one activity," as recited in Claim 41.

For the reasons discussed above, *Clark* further does not teach, "a second monitoring means, for monitoring said computing device for an occurrence of at least one event," as recited in Claim 32.

Boothby does not teach or suggest a "first monitoring means, for monitoring said computing device for an occurrence of at least one activity," or a "second monitoring means, for monitoring said computing device for an occurrence of at least one event," as recited in Claim 41. As discussed, *Boothby* teaches that, "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65.

Clark and *Boothby*, alone or in combination, do not teach or suggest a "first monitoring means, for monitoring said computing device for an occurrence of at least one activity," or a "second monitoring means, for monitoring said computing device for an occurrence of at least one event," as recited in Claim 41.

Clark further does not teach or suggest "a log generating means, for generating a log responsive to the occurrence of an event or activity monitored on said computing device," as recited in Claim 41.

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The Examiner states that a log generating means is "inherent in the system" and cites *Clark* (554-586 of Fig. 10) as teaching "for generating a log responsive to the occurrence of an event or activity monitored on said computing device," as recited in Claim 32. Applicants respectfully disagree. As described above, *Clark* teaches that "host file and handheld file names are obtained to allow comparison," not "generating a log responsive to the occurrence of an event or activity monitored on said computing device," as recited in Claim 41.

First, there is no log generating means in *Clark*, nor is such inherent in *Clark*. As will be described below, *Clark* does not teach "generating a log" at all and in fact, the method of *Clark* teaches to "determine if the last dates or times of the two files are different." *Clark*, col. 14, lines 59-60. As described by Applicants, however, a "Work Monitor can keep track of the file activities the user preforms so that files the user modifies or accesses on his home PC are synchronized with those on his office PC." *Specification*, page 9, lines 9-11.

The description of Fig. 10, cited by the Examiner, teaches that "[i]f the times or dates are different in step 554, control proceeds to step 558 to scan the two files for any differences and to collect a list of these differences." *Clark*, col. 14, lines 62-64. If there are differences, "control proceeds to step 560 where a pointer is placed at the beginning of a list. Control proceeds to step 564 to determine if the first entry is a conflicting entry. If so, control proceeds to step 566 to display the conflict. The user in step 568 then selects whether the handheld or the host entry is to be utilized." *Clark*, col. 14, line 64 - col. 15, line 10.

Clark teaches to "determine if the last dates and times of the two files are different," scan "for any differences,""determine if the first entry is a conflicting entry,"and then the user "selects whether the handheld or the host entry is to be utilized." *Id.* This in no way teaches or suggest a "log generating means, for generating a log responsive to the occurrence of an event or activity monitored on said computing device," as recited in Claim 41.

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As discussed, *Boothby* teaches "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65. Accordingly, *Boothby* does not teach or suggest "a log generating means, for generating a log responsive to the occurrence of an event or activity monitored on said computing device," as recited in Claim 41.

Clark and *Boothby*, either alone or in combination, do not teach or suggest each of the limitations of Claim 41.

Claims 42-44 ultimately depend from Claim 41 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claims 42-44 add their own limitations which render them patentable in their own right. Applicants reserve the right to argue these limitations should it become necessary in the future.

Accordingly, Claims 41-44 are believed patentable under 35 U.S.C. §103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejection of Claims 41-44 is requested.

E.   **Claims 45-51**

Amended claim 45 includes, among other limitations, "a work monitor interface, including information identifying an occurrence of an event or activity on the first computing device." It is respectfully submitted that *Clark* and *Boothby*, either alone or in combination, fail to teach or suggest this limitation.

The Examiner states that, "*Clark* teaches the method steps of identifying an occurrence of an event or activity by determining any differences between two files and if the entire file is new, col. 16, lines 4-27." *Office Action*, pages 5-6. The Examiner states that the means corresponding to this method is inherent in the system. *See id.* Applicants respectfully disagree.

Clark (col. 16, lines 4-27) describes scanning two files for <u>differences</u> and activating a "viewer module" so that "the particular differences are highlighted and shown to the user so that he can make a proper decision." *Clark* identifies differences between a file on a handheld and a file on a host. *Clark* does

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not identify "an occurrence of an event or activity <u>on the first computing device,</u>" as recited in Claim 45 (*emphasis added*). *Clark* merely teaches to determine differences between the file on the host and the file on the handheld. The files could be different because of changes or modifications made at either machine. Thus, *Clark* merely determines differences between two files, *Clark* does not identify an "occurrence of an event or activity on the first computing device," as recited in Claim 45. *Clark* merely identifies that two files are somehow different.

Boothby does not teach or suggest, "a work monitor interface, including information identifying an occurrence of an event or activity on the first computing device." As discussed, *Boothby* teaches, "[s]ynchronization begins with the program retrieving records from the handheld database and comparing them to the records in the status file." *Boothby*, col. 5, lines 63-65. *Boothby*, col. 5, lines 63-65. *Boothby* teaches a comparison of files, not an identification of "an occurrence of an event or activity of the first computing device," as recited in Claim 45.

Clark and *Boothby*, either alone or in combination, do not teach or suggest each of the limitations of Claim 45. Accordingly, Claim 45 is believed patentable over *Clark* in view of *Boothby*.

Claims 46-51 ultimately depend from Claim 45 and should therefore be patentable for at least the reasons discussed above. It is further submitted that Claims 46-51 add their own limitations which render them patentable in their own right. Applicants reserve the right to argue these limitations should it become necessary in the future.

Accordingly, Claims 45-51 are believed patentable under 35 U.S.C. § 103(a) over *Clark* in view of *Boothby* and withdrawal of the Examiner's rejection of Claims 45-51 is requested.

II.   CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including August 18, 2003.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 8/18/03
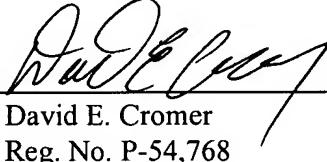
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